UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/960,755	10/29/1997	JANICE JOHNSON	JJOH0001	6489

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EXAMINER
GILLIGAN, CHRISTOPHER L

ART UNIT	PAPER NUMBER
3626	

DATE MAILED: 06/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<table>
<tr>
<td rowspan="2" style="text-align:center; vertical-align:middle;">Office Action Summary</td>
<td>Application No.
08/960,755</td>
<td>Applicant(s)
JOHNSON, JANICE</td>
</tr>
<tr>
<td>Examiner
Luke Gilligan</td>
<td>Art Unit
3626</td>
</tr>
</table>

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for R ply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL.**   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-7 and 22-36* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-7 and 22-36* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____ .

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

    a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)   4)☐ Interview Summary (PTO-413) Paper No(s). _____ .

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5)☐ Notice of Informal Patent Application (PTO-152)

3)☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . 6)☐ Other:

Response to Amendment

2.   In the amendment filed 6/11/01 in paper number 7, the following has occurred: claims 8-
21 have been canceled, claims 33-36 have been added, and claim 1-7 and 22-32 have been
amended. Now, claims 1-7 and 22-36 are presented for examination.

3.   The rejections under 35 U.S.C. 112 have been withdrawn by the Examiner based on
changes made by Applicant to the claims.

Claim Rejections - 35 USC § 103

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all
obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

5.   Claims 1-3, 22, 23, 29, 31, 32, and 34 are rejected under 35 U.S.C. 103(a) as being
unpatentable over Cummings, U.S. Patent No. 5,301,105 (as previously applied) in view of
Pitroda, U.S. Patent No. 5,590,038 (as previously applied).

6.   As per claim 1, Cummings teaches an integrated health care system for collecting,
consolidating, conforming, and distributing health care data concerning at least one individual
service recipient, the system comprising: at least one central host computer for maintaining,
consolidating, and distributing information generated by any component of said system (see
column 4, lines 4-21, in particular, Figure 1, element 10); wherein said centralized host
computer is one of a computer, or a network of linked computers having at least one central
server (see column 4, lines 4-21); at least one provider terminal in communication with said
central host computer (see column 4, lines 4-21, in particular, Figure 1, elements 11, 24, 27,
and 28); wherein said provider terminal is one of a portable computer, personal information

device, personal digital assistant, personal computer, or server computer (see column 7, lines 17-25); a billing module for calculating billing information for a service provided to the at least one individual service recipient (see column 5, lines 2-8); an insurance benefits module for calculating available insurance benefits for a service provided to the at least one individual service recipient (see column 4, lines 53-68); a payment module for electronically transferring funds to pay a bill for services provided to the at least one individual service recipient (see column 3, lines 22-26); an authorization module for authorizing service recipient treatment (see column 11, lines 37-43); a messaging module for providing messaging services to a component of said system (see column 4, lines 22-29); wherein said at least one service recipient's health care data records are stored on said central host computer and said provider terminal (see column 4, lines 30-39); wherein said central host computer and said provider terminal are electronically linked as a network, to permit information distribution to various locations on said network (see Figure 1); wherein said system is implemented using any of a global communications network, the Internet, or a local area network (see Figure 1); wherein said provider terminal includes: a medical insurer module; a health plan sponsor module; and individual service recipient module; a health care service provider module; a health care research module; and a service support module (see column 7, lines 50-68); wherein said medical insurer module includes functions for plan definition, open enrollment marketing features, automated authorization of benefits, automated referrals, and service payment accounting (see column 4, lines 53-52); wherein said health plan sponsor module includes functions for open enrollment processes, benefit plan information maintenance, and coordination of distribution and activation or deactivation of individuals (see column 9, lines 9-25); wherein said health care service provider module includes functions for maintaining service recipient records, diagnosing and treating service recipient ailments, managing service

payments, accounting services, and maintaining service provider records, including licensing

information, staffing affiliations, organizational ownership information, tax identification

information, curriculum vitae of licensed practitioners, as well as information regarding

disciplinary actions (see column 6, line 44 – column 7, line 2); wherein said health care research

module includes functions for collecting data on said system for research and analysis of health

care issues (see column 10, line 66 – column 11, line 10); wherein the service support module

includes functions for service parameter maintenance, product support, customer requests, and

system maintenance (see column 14, lines 39-48); wherein said system provides access to

Social Security, annuity, retirement account, and benefit information (see column 5, lines 11-

18); wherein said medical insurer module, said health plan sponsor module, said individual

service recipient module, said health care service provider module, said health care research

module, and said service support module include databases for storing information (see column

4, lines 30-39); wherein said information is linked and organized by at least one indexing key

(see column (see column 4, lines 30-39, it is noted that indexing keys are utilized for linking

relational databases).

7.   Cummings does not explicitly teach a portable individual information device for

accessing said system, said device being any of an integrated circuit card, a magnetic storage

card, or a portable integrated circuit or microchip based device. Pitroda teaches portable

individual information device for accessing said system, said device being any of an integrated

circuit card, a magnetic storage card, or a portable integrated circuit or microchip based device

(see column 2, lines 44-55, in particular, the UET card is a portable integrated circuit or

microchip based device). Pitroda further teaches that the portable individual information device

stores health care data records for the individual (see column 5, lines 44-59). It would have

been obvious to one of ordinary skill in the art of healthcare management at the time of the

invention to incorporate the portable individual information device of Pitroda into the centralized

health management system of Cummings. One of ordinary skill in the art would have been

motivated to incorporate such a feature for the purpose of enhance healthcare efficiency and

reduce overhead costs by providing personalized storing devices.

8.   As per claim 2, Cummings in view of Pitroda teach the system of claim 1 as described

above. Cummings further teaches that open standards are used for hardware, software, and

firmware components of said system (see Figure 1 and column 4, lines 4-62).

9.   As per claim 3, Cummings in view of Pitroda teach the system of claim 1 as described

above. Cummings further teaches the health care research module converts said health care

data on said system into one common format for use by said central host computer (see column

10, line 66 – column 11, line 10, it is assumed that test results would need to converted to a

common format for use throughout the system).

10.   Claims 31, 32, and 34 contains substantially similar method limitations to system

limitations recited in claims 1-3 and, as such, is rejected for similar reasons given above.

11.   As per claim 22, Cummings teaches an integrated healthcare system, implemented

using any of a global communications network, the Internet or a local area network, the system

comprising: at least one central host computer for maintaining, consolidating, and distributing

information generated by any component of said system (see column 4, lines 4-21, in particular,

Figure 1, element 10); at least one provider terminal in communication with said central host

computer (see column 4, lines 4-21, in particular, Figure 1, elements 11, 24, 27, and 28);

wherein said provider terminal is one of a portable computer, personal information device,

personal digital assistant, personal computer, or server computer (see column 7, lines 17-25);

wherein said provider terminal is operable to communicate with said entire system or any

portion of said system, or is operable independently from said system (see column 4, lines 4-

14); a messaging module for providing messaging services to a component of said system (see

column 4, lines 22-29); wherein said service recipient's health care data records are stored on

said central host computer and said provider terminal (see column 4, lines 30-39); wherein said

central host computer and said provider terminal are electronically linked as a network, to permit

information distribution to various locations on said network (see Figure 1); wherein open

standards are used for hardware, software, and firmware components of said system (see

Figure 1 and column 4, lines 4-62); wherein said provider terminal includes: a medical insurer

module including functions for plan definition, open enrollment marketing features, automated

authorization of benefits, automated referrals, and service payment accounting (see column 4,

lines 53-52); a health plan sponsor module including functions for open enrollment processes,

benefit plan information maintenance, and coordination of distribution and activation or

deactivation of individuals (see column 9, lines 9-25); a health care service provider module

including functions for maintaining service recipient records, diagnosing and treating service

recipient ailments, managing service payments, accounting services (see column 6, line 44 –

column 7, line 2); a health care research module including functions for collecting data on said

system for research and analysis of health care issues (see column 10, line 66 – column 11, line

10); and a service support module includes functions for service parameter maintenance,

product support, customer requests, and system maintenance (see column 14, lines 39-48).

12.   Cummings does not explicitly teach a portable individual information device or a card

reader for accessing said system and transmitting information to the device, said device being

any of an integrated circuit card, a magnetic storage card, or a portable integrated circuit or

microchip based device. Pitroda teaches portable individual information device for accessing

said system, said device being any of an integrated circuit card, a magnetic storage card, or a

portable integrated circuit or microchip based device (see column 2, lines 44-55, in particular,

the UET card is a portable integrated circuit or microchip based device). Pitroda further teaches that the portable individual information device stores health care data records for the individual (see column 5, lines 44-59). Pitroda further teaches a card reader linked to said provider terminal, for accessing and transmitting information among said portable individual information device and any of said components of said system (see column 4, lines 35-41). It would have been obvious to one of ordinary skill in the art of healthcare management at the time of the invention to incorporate the portable individual information device of Pitroda into the centralized health management system of Cummings. One of ordinary skill in the art would have been motivated to incorporate such a feature for the purpose of enhance healthcare efficiency and reduce overhead costs by providing personalized storing devices.

13.   As per claim 23, Cummings in view of Pitroda teach the system of claim 22 as described above. Cummings further teaches said health care services provider module further includes a function for maintaining service provider records, including licensing information, staffing affiliations, organizational ownership information, tax identification information, curriculum vitae of licensed practitioners, as well as information regarding disciplinary actions (see column 6, line 44 – column 7, line 2).

14.   As per claim 29, Cummings in view of Pitroda teach the system of claim 23 as described above. Cummings further teaches said centralized host computer is one of a computer, or a network of linked computers having at least one central server (see column 4, lines 4-21).

15.   Claims 4 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cummings, U.S. Patent No. 5,301,105 (as previously applied) in view of Pitroda, U.S. Patent No. 5,590,038 and further in view of Edelson et al., U.S. Patent No. 5,737,539.

16.   As per claim 4, Cummings in view of Pitroda teach the system of calim 3 as described

above. Cummings does not explicitly teach stripping health care data of any personal

information that might compromise the anonymity of the individual service recipient from whom

the health care data was collected before distributing the information to any other component of

the module. Edelson teaches stripping health care data of any personal information that might

compromise the anonymity of an individual service recipient from whom health care data was

collected before distributing the information to any other component of a module (see column

18, lines 15-25). It would have been obvious to one of ordinary skill in the art of healthcare

management at the time of the invention to incorporate this anonymity feature into the system of

Cummings. One of ordinary skill in the art would have been motivated to incorporate such a

feature for the purpose of enhancing privacy features for patients.

17.   Claim 36 contains substantially similar method limitations to system claim 4 and, as

such, is rejected for similar reasons given above.

18.   Claims 5-7, 24-28, 30, 33, and 35 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Cummings, U.S. Patent No. 5,301,105 (as previously applied) in view of

Pitroda, U.S. Patent No. 5,590,038 and further in view of Ertel, U.S. Patent No. 5,307,262.

19.   As per claim 5, Cummings in view of Pitroda teach the system of claim 1 as described

above. Cummings does not explicitly teach including a statistical analysis module for providing

statistical analysis of said common-format health care data stored in said system. Ertel teaches

including a statistical analysis module for providing statistical analysis of said common-format

health care data stored in said system (see column 6, lines 9-23). It would have been obvious

to one of ordinary skill in the art of healthcare management at the time of the invention to

incorporate the data analysis feature of Ertel into the system of Cummings. One of ordinary skill

in the art would have been motivated to include such a feature for the purpose of enhancing

accuracy in patient records over time (see column 5, lines 35-39 of Ertel).

20.   Claim 33 and 35 contains substantially similar method limitations to system claim 5 and,

as such, is rejected for similar reasons given above.

21.   As per claim 6, Cummings in view of Pitroda and Ertel teach the system of claim 5 as

described above. Cummings does not explicitly teach a card reader linked to said provider

terminal, for accessing and transmitting information among said portable individual information

device and any of said components of said system. Pirtroda teaches a card reader linked to

said provider terminal, for accessing and transmitting information among said portable individual

information device and any of said components of said system (see column 4, lines 35-41). It

would have been obvious to one of ordinary skill in the art of health care management to

incorporate this card reader feature into the system of Cummings for the reasons given above

with respect to claim 1.

22.   As per claim 7, Cummings in view of Pitroda and Ertel teach the system of claim 6 as

described above. Cummings further teaches said provider terminal is operable to communicate

with said entire system or any portion of said system, or is operable independently from said

system (see column 4, lines 4-14).

23.   As per claim 24, Cummings in view of Pitroda teach the system of claim 23 as described

above. Cummings does not explicitly teach including a statistical analysis module for providing

statistical analysis of said common-format health care data stored in said system. Ertel teaches

including a statistical analysis module for providing statistical analysis of said common-format

health care data stored in said system (see column 6, lines 9-23). It would have been obvious

to one of ordinary skill in the art of healthcare management at the time of the invention to

incorporate the data analysis feature of Ertel into the system of Cummings. One of ordinary skill

in the art would have been motivated to include such a feature for the purpose of enhancing accuracy in patient records over time (see column 5, lines 35-39 of Ertel).

24.   As per claim 25, Cummings in view of Pitroda and Ertel teach the system of claim 24 as described above. Cummings further teaches a billing module for calculating billing information for a service provided to the at least one individual service recipient (see column 5, lines 2-8).

25.   As per claim 26, Cummings in view of Pitroda and Ertel teach the system of claim 25 as described above. Cummings further teaches an insurance benefits module for calculating available insurance benefits for a service provided to the at least one individual service recipient (see column 4, lines 53-68).

26.   As per claim 27, Cummings in view of Pitroda and Ertel teach the system of claim 24 as described above. Cummings further teaches a payment module for electronically transferring funds to pay a bill for services provided to the at least one individual service recipient (see column 3, lines 22-26).

27.   As per claim 28, Cummings in view of Pitroda and Ertel teach the system of claim 24 as described above. Cummings further teaches an authorization module for authorizing service recipient treatment (see column 11, lines 37-43).

28.   As per claim 30, Cummings in view of Pitroda and Ertel teach the system of claim 24 as described above. Cummings further teaches said system provides access to any of Social Security, annuity, retirement account, and benefit information (see column 5, lines 11-18). Cummings does not explicitly teach providing comparative statistical analysis. Ertel teaches providing comparative statistical analysis (see column 15, lines 12-20). It would have been obvious to one of ordinary skill in the art of healthcare management at the time of the invention to incorporate the data analysis feature of Ertel into the system of Cummings. One of ordinary

skill in the art would have been motivated to include such a feature for the reasons given above with respect to claim 24.

Response to Arguments

29.   In the remarks filed 6/11/01 in paper number 7, Applicant argues in substance that the combination of Cummings and Pitroda fails to teach certain features as currently recited in the claims. However, these arguments are moot in view of the new grounds of rejection. It particular, it should be noted that the data input terminals of Cummings are now relied upon to teach the claimed provider terminal, while Pitroda is relied upon for the claimed individual information device.
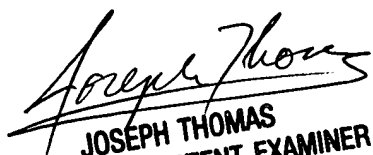
Conclusion

30.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luke Gilligan whose telephone number is (703) 308-6104. The examiner can normally be reached on Monday-Friday 8am-5:30pm.

31.   If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (703) 305-9588. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703)305-7687 for After Final communications.

32.   Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

CLG
June 16, 2003

JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600